

REMARKS

This is in full and timely response to the Office Action mailed May 14, 2003. Entry of this Amendment is proper under 37 C.F.R. §1.116 since the amendment: (a) places the application in condition for allowance (for the reasons discussed herein); (b) does not raise any new issues requiring further search and/or consideration; (c) satisfies a requirement of form asserted in the previous Office Action; and (d) places the application in better form for appeal, should an appeal be necessary. The amendment is necessary and was not earlier presented because it is made in response to arguments raised in the final rejection. Entry of this amendment is respectfully requested. Reexamination and reconsideration in light of the above amendments and the following remarks is respectfully requested.

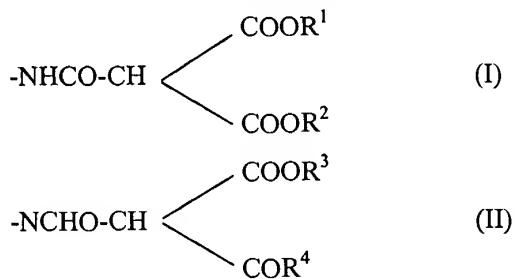
By this Amendment, claim 1 was amended, and claim 15 was cancelled without prejudice or disclaimer to its underlying subject matter. Claim 1 was amended to delete the second set of possible monohydric alcohols, thereby reducing the issues. No new matter was added. Claims 1-4 and 7-14 are pending in this application, with claim 1 being independent. By this Amendment, Applicant believes that all pending claims are in condition for allowance. Reexamination and reconsideration in light of the above amendments and the following remarks is respectfully requested.

Applicant thanks the examiner for indicating that claim 4 is allowable, and would be allowed if presented in independent form. As Applicants believe that all pending claims are allowable, Applicants respectfully decline to present claim 4 in independent form at this time.

Rejections under 35 U.S.C. §102 and 103

Claims 1, 2, 7-12 and 14-15 are rejected under 35 U.S.C. § 102(b) as being anticipated by, or alternatively, under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,126,424 to Brindöpke et al. Claim 15 was cancelled, mooted this portion of the rejection. Applicants respectfully traverse this rejection.

Claim 1 recites a blocked isocyanate group-containing resin composition, comprising a resin (C) obtainable by modifying a resin (A) having, in one molecule, two or more blocked isocyanate groups represented by formula (I) or (II):



where R¹, R², R³, and R⁴, which are same or different, each represents a substituent having 1 to 10 carbon atoms, with a monohydric alcohol (B), where (B) is one or more compounds selected from the group consisting of mono (or oligo)propylene glycol monoalkyl ethers having 4 to 10 carbon atoms, and mono (or oligo)ethylene glycol monoalkyl ethers having 4 to 10 carbon atoms, replacing at least one of the R¹, R², and R³; wherein the resin (C) has a lowered solubility parameter as compared with the resin.

Brindöpke discloses in Example 1 (col. 12, lines 20 to 34) that a resin that would read on the present resin (A)(I) is prepared by blocking hexamethylene diisocyanate using dibutyl malonate. See also col. 3, line 53 for the use of compounds that are larger than dibutyl malonate. However, in order to reach the present claim 1, the blocked resin of Brindöpke would need to be reacted with a monohydric alcohol. The Examiner appears to ignore this point. In fact, glycol compounds are co-reacted with the blocked resin, and there is no teaching or suggestion in the reference of a monohydric alcohol being reacted with the blocked resin in the cited reference. The Examiner points to col. 8, line 21 of Brindöpke for a teaching that the blocked resin is mixed and/or reacted with a binder (B) which must be a polyol compound. However, it appears that the Examiner makes this point in reference to present claims 12 to 14, and not with regard to a reaction with a monohydric alcohol, and since a polyol compound has more -OH groups than a

monohydric alcohol by definition, it is clear that Brindöpke fails to teach or suggest the blocked isocyanate group-containing resin of the present invention.

A document can only anticipate a claim if the document discloses, explicitly or implicitly, each and every feature recited in the claim. Verdegall Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Since Brindöpke fail to disclose, either explicitly or implicitly, teach or suggest at least the above-noted elements recited in independent claim 1, Brindöpke cannot anticipate the claim. At least in view of the foregoing, claim 1 is allowable, and the §102 rejection should be reconsidered and withdrawn.

Additionally, as all of the claim elements are not disclosed, taught or suggested in Brindöpke, a *prima facie* case for obviousness has not been presented. Accordingly, the §103 rejection of claim 1 should be reconsidered and withdrawn.

Additionally, claims 2, 7-12 and 14-15, being dependent upon allowable claim 1, are also allowable for the reasons above. Moreover, this claim is further distinguished by the additional features recited therein, particularly within the claim combination.

Accordingly, withdrawal of the §102 and §103 rejections is respectfully requested.

Claims 1-3 and 7-15 are rejected under 35 U.S.C. § 102(b) as being anticipated by, or alternatively, under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,274,693 to Poth et al. Claim 15 was cancelled, mooted this portion of the rejection. Applicants respectfully traverse this rejection.

Poth teaches that a resin (B1) is prepared by blocking a di- or polyisocyanate, such as hexamethylene diisocyanante (col. 11, line 60 to col. 12, line 14) using diisopropyl malonate. Poth also teaches that a resin (B2) that is prepared by reacting 2-butanol to a compound having an exposed and available isocyanate compound. Referring to the latter passage in Poth, as well as column 8, lines 25 to 42, the product from this reaction is reacted with a hydroxyl-containing compound, which may be a monohydric alcohol such as n-butanol. The major difference between Poth and the present invention is that Poth prefers the use of polyols over monohydric alcohols, although Poth apparently mentions of a monohydric alcohol as one option. Also, Poth teaches that the purpose for adding the alcohol is to react any free isocyanate groups (col. 8, line 47 to col. 9, line 16), while the present claims recite that the monohydric alcohol is to replace an R group in formulae (I) and (II) claim 1.

Although Poth teaches that the alcohol is preferably a compound having more than two carbon atoms, the largest monohydric alcohol disclosed by Poth is n-butanol which has only 4 carbon atoms. Consequently, it is clear that Poth fails to teach or suggest the features of the presently claimed invention.

A document can only anticipate a claim if the document discloses, explicitly or implicitly, each and every feature recited in the claim. Verdegall Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Since Poth fail to disclose, either explicitly or implicitly, teach or suggest at least the above-noted elements recited in independent claim 1, Poth cannot anticipate the claim. At least in view of the foregoing, claim 1 is allowable, and the §102 rejection should be reconsidered and withdrawn. Additionally, as all of the claim elements are not disclosed, taught or suggested in Poth, a *prima facie* case for obviousness has not been presented. Accordingly, the §103 rejection of claim 1 should be reconsidered and withdrawn.

Additionally, claims 2-3 and 7-15, being dependent upon allowable claim 1, are also allowable for the reasons above. Moreover, this claim is further distinguished by the additional features recited therein, particularly within the claim combination.

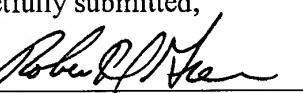
Accordingly, withdrawal of the §102 and §103 rejections is respectfully requested.

Conclusion

For the foregoing reasons, claims 1-4 and 7-14 are allowable, and the present application is in condition for allowance. Accordingly, favorable reexamination and reconsideration of the application in light of these amendments and remarks is courteously solicited. If the examiner has any comments or suggestions that would place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number below.

Dated: July 11, 2003

Respectfully submitted,

By 
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